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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,594	05/25/2000	Haruyasu Ueda	826.1606/JDH	7152

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EXAMINER

ENG, DAVID Y

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 05/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/577,594

Applicant(s)

UEDA, HARUYASU

Examiner

DAVID Y. ENG

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 4-8, 12-16 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-11 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.                      6) ☐ Other: \_\_\_\_\_

The information disclosure statement filed 5/25/2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The citation of the Costales et al. reference in Form 1449 is crossed out because there is no copy provided to the Examiner.

In regard to the headings, Applicant is suggested to either center the heading "Background of the Invention" or indent the two subheadings "Field of the Invention" and "Description of the Related Arts" such that a reader would not have the impression that details of the Background of the Invention are missing.

In the communication filed on April 18, 2003, Applicant elects with traverse Group I, claims 1-3, 9-11 and 17 for examination. Claims 4-8, 12-16 and 18 are therefore withdrawn from consideration. Applicant contended that restriction is not proper because receiving email and blocking junk mail could not be separated and the two Groups are classified in the same area. The two inventions are distinct because the received emails as recited in Group II are not necessary junks. Although they are classified in the same area, the search of receiving emails is different from the search of blocking junk mails. The restriction is proper.

Claims 2, 3, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 2 and 3, there is no functional relationship between the specifying unit and the components of its parent claim 1. Claims 10 and 11 have similar defect.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 9-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch (USP 6,546,416) in view of Miloslavsky (USP 5,765,033).

See at least the abstract, lines 53-65 of column 7 and line 61-67 of column 8 in Kirsch. Kirsch teaches a method and device for blocking junk e-mail, comprising:

A mailing address receiving means (inherent) for receiving mailing address of e-mails,

A storing unit registering a processing method for the received e-mail in corresponding with a particular mail address or address pattern (see the accept list and the reject list in line 53-65 of column 7); and

A mail processing unit making a matching between the mail address of the received e-mail and mail addresses or address patterns registered to said storing unit, and processing the received e-mail based on a processing method obtained as a result of the matching (see how rejected e-mails are discarded in line 61-67 of column 8 in Kirsch).

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Although Kirsch has a mailing address receiving means, Kirsch did not explicitly state whether the mailing address of an e-mail is extracted. However, Miloslavsky teaches an electronic mail system having an e-mail mailing address extractor for extracting mailing address of e-mail (see line 34-37 of column 4). From the teaching of Miloslavsky, it would have been obvious to a person of ordinary skill in the art to provide a mail address extractor in Kirsch such that mailing address of Kirsch's e-mail is extracted for matching with addresses in the lists.

As to claims 2 and 10, the input device for making the accept and reject lists in Kirsch can be considered as specifying unit.

As to claims 3 and 11, encryption is well known in the art.



DAVID Y. ENG  
PRIMARY EXAMINER